

### **REMARKS/ARGUMENTS**

Claims 1-114 are pending in the application. Claims 81-114 have been withdrawn from consideration. Claims 1-80 are rejected.

Also, in order to obtain a varying scope of coverage on Applicants' invention, dependant claims 115-117 are newly presented. These claims, which depend from claim 1, are fully supported in the specification and claims as filed; no new matter has been added. Also, they are drawn to the elected invention of Group I and are considered immediately allowable over the cited art.

Applicants wish to thank the examiner for the courteous interviews of 7/14/06 and 8/01/06. At the 7/14/06 interview, Applicants and Applicants' representative discussed the operation of Applicants' invention. At the 8/01/06 interview, Applicants' representative discussed amendments for overcoming several of the objections and the rejections. The examiner indicated that the proposed amendments would overcome the objections and the U.S.C. § 101 rejections. Also, Applicants' representative indicated that the cited reference Gustilo, failed to teach several elements of Applicants' invention.

#### **Election/Restrictions**

Claims 81-114 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention, there being no allowable generic or linking claim. Applicants respectfully traverse the restriction requirement for reasons of record.

#### **Objections**

The Examiner has objected to claims 30-38. Applicants have amended the claims as suggested by the Examiner.

**Rejections under 35 USC § 112**

Claim 73 is rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully point out that antecedent basis for the "cut surface" in claim 73 is found in claim 70 from which claim 73 depends. Accordingly, withdrawal of the rejection is respectfully requested.

**Rejections under 35 USC § 101**

Claims 26-27, 34, 66-67, and 74 are rejected under 35 U.S.C. 101 allegedly because they are drawn to non-statutory subject matter. Applicants respectfully traverse this rejection in that the claims are drawn to statutory subject matter. Applicants are not claiming any portion of the human body. To further clarify that Applicants do not intend to claim portions of the human body, claims 26, 34, 66 and 74 have been amended as discussed with the Examiner. In view of these amendments, withdrawal of the rejection is respectfully requested.

**Rejections under 35 USC § 102**

Claims 1-19, 21-22, 28, 30-33, 35-40, 42-53, 55-59, 61-62, 70-73, 75-80 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Gustilo et al. (U.S. Patent No. 5,733,292). Applicants respectfully traverse this rejection in that Gustilo fails to teach or suggest several elements of Applicants' invention. Applicants will discuss these deficiencies in turn.

The first deficiency of Gustilo arises from the fact that, contrary to the Examiner's assertion, it does not teach or suggest an adjustable femoral member. This is due to the fact that Gustilo's femoral component 142 is fixed in all embodiments and thus can not be adjustable. See Gustilo, e.g., at Col 13, lines 50-54 which teaches that femoral component 141 wraps around the end of the femur. See also Gustilo Figs. 27 and 29. Gustilo's femoral component simply can not be adjusted from this wrapped position. The inability to adjust Gustilo's femoral component is further evidenced by the fact that it is Gustilo's specific and required teaching that the femur is cut before its femoral component is attached. See Gustilo, e.g., at Col 13, lines 34-36; lines 40-

41 ("sufficient cutting must be done"); lines 50-52 ("several cuts are usually performed on the femur since the femoral component 154 wraps around the end of the femur 155); and Col 14, lines 10-11. Gustilo's femoral component is thus fixed by design. Moreover, modifying this design of Gustilo would teach away from its express intention that the femur is cut before its femoral component 142 is attached.

The rejection is also deficient in that, contrary to the Examiner's contention, elements 400 and 402 are not adjustable femoral members. Rather, they are springs attached to Gustilo's tibial component by design. See Gustilo, e.g., at Col 12, lines 20-25 and Figs. 22 and 23. They are in no way attached to Gustilo's femoral component 142 and thus can not be femoral components adjustable or otherwise.

In addition to the above deficiencies, contrary to the Examiner's assertions, Gustilo does not and can not teach a positioning feature that moves relative to the femur as the femoral member is adjusted. This is the case for several reasons. First, as discussed above, Gustilo's femoral component 142 is fixed in all embodiments. Second, Gustilo provides no teaching whatsoever of a positioning feature. In fact, Gustilo actually teaches away from a positioning features since its femoral component is fixed onto a femur that was cut before the femoral component was attached. In the same regard, Gustilo teaches away from identifying a position on the distal femur for facilitating completion of a surgical procedure since it teaches that its surgical procedure on the femur is completed before its femoral member is even applied.

The Examiner has specifically contended that Gustilo's elements 406 and 128 are positioning features. However, in addition to the reasons above, the specifics of Gustilo's disclosure teach away from such an interpretation. For example, Gustilo teaches that element 406 is a screw located on its tibial component. See Gustilo e.g., at Col 12, lines 2-25. It can not move as springs 400 and 402 move and it identifies no location on the femur. To the complete contrary, it is moved to move springs 400 and 402. *Id.* ("The springs 400 expand as the screw 406 is advanced to increase the width of the trial"). Thus, element 406 is not taught to be a positioning feature and it can not function as a positioning feature.

Elements 128 are also neither taught to be nor can function as a positioning feature. This is the case for three reasons. First, they are blind holes and thus can in no way identify a position on the femur. Second, they are not even positioned over the femur. Third, they are not adjustable, but rather are used as an insert for a wrench used to move screw 405. See Gustilo, e.g., at Col 8, lines 55-50.

As discussed above, Gustilo fails to teach at least two element of Applicants' invention and in fact, actually teaches away from these elements. The courts have held that anticipation requires that a single reference teach all elements of the claimed invention. Applicants respectfully point out that it is not sufficient that the claims under attack merely read on something in the cited reference (as was suggested on page 7 of the office action). Instead, the correct legal standard for anticipation requires that "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." MPEP 2131 (quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). See also *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383 (Fed. Cir. 2001) (quoting *Richardson*). Clearly, Gustilo falls far short of this requirement. Accordingly, withdrawal of the rejection is respectfully requested.


Applicants also wish to point out that their products associated with this application are being used to bring tangible benefits to peoples' lives by improving the outcomes of total knee implant procedures that are performed on large numbers of patients in this country with activity limiting arthritis. Accordingly, Applicants wish to thank the examiner for her assistance in expediting the prosecution of this application to allowance.

**CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

It is believed that no fees are due with this response; however, should any fees be required under 37 C.F.R. §§ 1.16 to 1.21 for any reason, the Commissioner is authorized to charge Deposit Account No 20-1430. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

  
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